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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,373	08/21/2003	Craig D. Tipton	3202R	7486
26645	7590	10/07/2008	EXAMINER	
THE LUBRIZOL CORPORATION			RONESI, VICKEY M	
ATTN: DOCKET CLERK, PATENT DEPT.			ART UNIT	
29400 LAKELAND BLVD.			PAPER NUMBER	
WICKLIFFE, OH 44092			1796	
MAIL DATE		DELIVERY MODE		
10/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/645,373	<b>Applicant(s)</b> TIPTON ET AL.
	<b>Examiner</b> VICKEY RONESI	<b>Art Unit</b> 1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 20 June 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1,6-8,10-28 and 30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,6-8,10-28 and 30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/95/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 6/20/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 6/20/2008. In particular, claim 30 is new. Thus, the following action is properly made final.

***Claim Rejections - 35 USC § 103***

4. Claims 1, 6-8, 10, 12-28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 4,136,043) in view of Le Suer '936 (US 4,087,936).

With respect to claims 1, 6-8, 10, and 12-28, the rejection is adequately set forth in paragraph 6 of Office action mailed on 6/7/2007 and is incorporated here by reference.

With respect to new claim 30, the rejection set forth in paragraph 6 of Office action mailed on 6/7/2007 encompasses this new claim and is therefore incorporated here by reference

5. Claims 1, 6-8, 10, 11, 12-28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 4,136,043) in view of Le Suer '936 (US 4,087,936) and further in view of Le Suer (US 3,502,677).

With respect to claims 1, 6-8, 10, and 12-28, the rejection is adequately set forth in paragraph 7 of Office action mailed on 6/7/2007 and is incorporated here by reference.

With respect to new claim 30, the rejection set forth in paragraph 7 of Office action mailed on 6/7/2007 encompasses this new claim and is therefore incorporated here by reference

***Response to Arguments***

6. Applicant's arguments filed 12/3/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that declaration by Dr. Patterson filed on 12/3/2007 is sufficient to establish the superiority of the present invention over that of Davis and (B) that the data in the declaration is reasonably commensurate in scope with the scope of the claims.

With respect to argument (A), the data is not a proper comparison to the closest prior art of Le Suer '936, which discloses and exemplifies boric acid and not long chain alkyl borates. Case law holds that comparative showings must compare the claimed subject matter with the closest prior art to be effective. See *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 71 (CCPA 1979).

With respect to argument (B), the data is not reasonably commensurate in scope with the scope of the claims given that the exemplified borating agent is boric acid, wherein neither boron trioxide nor alkyl borates are exemplified. Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds). *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978). Second, it is not shown if the evidence of superior properties would be had through all ratios of reactants. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of

nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d). Specifically, only a formulation with a ratio of 1000 parts succinimide dispersant : 14 parts DMTD : 30 parts boric acid is given. The examples from the specification as originally filed fail to buttress the data of the declaration (ratios of succinimide : DMTD : boric acid are at 1000 : 14 : 30) because the ratios are the same.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/26/2008  
Vickey Ronesi

/V. R./  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796